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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/617,732 07/17/00 CUMMINGS

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EXAMINER

QM22/0622

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ART UNIT

PAPER NUMBER

3728

DATE MAILED:

06/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/617,732

Applicant(s)
Cummings et al

Examiner
Marie Patterson

Art Unit
3728



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 21, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-11 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

Art Unit: 3208

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the heel member spanning the length and width of said heel as claimed in claims 10 and 11 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Specification

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

- (a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.
- (b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.
- (c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

Art Unit: 3208

The specification is objected to under 37 CFR 1.71 because it fails to provide an adequate written description of the invention and fails to adequately teach how to make and/or use the invention, i.e. fails to provide an enabling disclosure.

In the specification reference is made to element 21 in figure 1 as a forefoot wedge member, however later in the specification reference is made to element 117 shown in figure 5 as the forefoot wedge. Element 21 of figure 1 appears to be similar to the forefoot stabilizer, element 111 shown in figure 4. This is confusing, and it is not clear what limitations applicant intends to encompass with the use of such terms. Applicant is reminded that terminology should remain consistent throughout the specification and the claims.

On page 4 of the specification applicant states that "The lateral forefoot wedge 21 istapered from medial to lateral from the middle of the forefoot", and in the drawings element 21 does not extend from the middle of the forefoot, it appears to be located only at the edge of the sole (specifically in figures 2 and 3). It also is not shown to be tapered from medial to lateral.

In the specification there is reference to a heel counter, however no such element is shown in the drawings. The only similar element to what is conventionally known as a heel counter is the back piece shown in figure 1 and the element which appears to be the same possibly shown at the rear of the shoe in figure 4. However in the specification applicant recites that the heel stabilizer (113) is "conformably attached to the lateral heel counter and encompasses substantially the entire heel counter from the distal end 113A to the proximal end 113B" (page 6). This is confusing since if one assumes the element shown at the rear of the shoe is the heel counter then the

Art Unit: 3208

stabilizer shown in figure 4 extends forward of the distal end of heel counter and definitely does not encompass the entire heel counter from the proximal end of the heel counter to the distal end.

In the specification on page 6 applicant states that "the wedge 115 spans the entire length and width of the heel", however as shown in figures 5 and 7 this does not appear to be true., the wedge appears to only span about ½ of the width of the heel.

Claim Rejections - 35 USC § 112

3. Claims 8-11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See above.

4. Claims 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 8 the phrases "conformally attached" and "a lateral heel stabilizer....extending from the proximal end of said heel stabilizer to the distal end of said heel stabilizer" are confusing, vague, and indefinite.

Claims 10 and 11 are confusing, vague, and indefinite because it is not clear in view of the discrepancies in the drawings and specification what structural limitations applicant intends to encompass with such language.

Art Unit: 3208

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noone (4866861) in view of Lyne (2179942).

Noone shows a shoe with a forefoot lateral wedge (20) and a heel counter (figure 3) with a lateral heel stabilizer (62) substantially as claimed except for tapering the forefoot lateral wedge. Lyne teaches tapering a protruding wedge (see figure 6). It would have been obvious to taper the wedge of Noone as taught by Lyne to provide a smooth transition between the sole and the wedge.

Noone as modified above discloses the claimed invention except for the exact thickness of the wedge. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the wedge with a thickness of between 1/8 to 1/4 inch, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

7. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blissett in view of Noone.

Art Unit: 3208

Blissett shows a shoe with a tapered forefoot wedge and a tapered heel wedge (see column 3 line 35- column 4 line 6) substantially as claimed except for a lateral heel stabilizer. Noone teaches providing a lateral heel stabilizer (62). It would have been obvious to provide a lateral heel stabilizer as taught by Noone in the shoe of Blissett to make the shoe able to assist a wearer when playing golf.

In reference to claim 9, Blissett as modified above discloses the claimed invention except for the exact ranges of thicknesses as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the forefoot wedge 1/8-1/4 inch thick, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Response to Arguments

8. Applicant's arguments filed 5/21/01 have been fully considered but they are not persuasive.

In response to Applicant's piecemeal analysis of the references, it has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. *In re Keller*, 208 USPQ 871 (CCPA 1981).

In response to applicants' arguments directed towards the intended use of the shoe, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be

Art Unit: 3208

employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

In response to applicants' arguments directed towards the shape and location of a "heel stabilizer", Noone teaches and shows a heel stabilizer (62) attached to a heel counter (shown in the drawings) inasmuch as applicant has disclosed and shown such.

9. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the Tech Center 3700 **Customer Service Center** number is **(703)306-5648**.

For applicant's convenience, the Group Technological Center FAX number is (703) 305-3580. Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted.

Inquiries concerning the merits of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Valerie Douglas at (703)308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.


Marie Patterson

Primary Examiner
Art Unit 3728

MDP
June 21, 2001

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.